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Docket No.: NU-01005
JTL.005

AMENDMENT TO THE DRAWINGS

The drawings are amended by the addition of the Figure 5 submitted herewith.

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REMARKS

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 2 and 3 are presently pending in the application and have been amended to more particularly define the invention, without affecting the scope of the claimed subject matter.

The Office Action objects to the drawings as not showing "causing the trader to file an application for a patent on the intellectual property in a Patent Office," as recited in claims 2 and 3. While Applicant submits that all claimed subject matter is clearly shown in the drawings, to expedite prosecution submitted herewith is new drawing Figure 5 which tracks claim 3. The specification has been amended to accommodate Figure 5, also tracking claim 3. No new matter has been added. Accordingly, the objection to the drawings is overcome.

Claims 2 and 3 were rejected under 35 U.S.C. §112, first paragraph, with the contention that there is no disclosure of causing the trader to file an application for a patent on the intellectual property in a Patent Office. Claims 2 and 3 were also rejected under 35 U.S.C. §112, second paragraph, with the contention that "causing" results in the claims being unclear. Claims 2 and 3 have been amended to remove "causing," instead simply stating that the trader performs the various actions. Accordingly, the rejections under 35 U.S.C. §112, first paragraph and second paragraph, are overcome.

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wong, United States Patent No. 6,115,690, in view of United States Code Title 35 – Patents. This rejection is respectfully traversed.

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Wong discloses an integrated business-to-business Web commerce and business automation system. Sellers are able to provide information about the goods and services which they offer for sale, and buyers who view that information are able to purchase desired goods and/or services directly from the sellers. The transactions are initiated by the sellers presenting data about the goods and services which they are offering for sale. A buyer who wants particular goods or services must locate a seller offering the desired goods or services.

In contrast, in the claimed invention, a transaction involving intellectual property or industrial property is initiated when a trader presents a purchase offer. A seller, seeing that purchase offer, provides a sale offer, and if the trader accepts the sale offer, the trader purchases the intellectual property or industrial property. If the property is intellectual property, the trader files an application for a patent on the intellectual property in a Patent Office. Subsequently, the trader sells the intellectual property or the industrial property to a buyer. In addition to these things, the trader takes other steps, for example registering information about the property.

First of all, then, in the claimed invention, the transaction is initiated by the trader, not by a seller. This relieves sellers of finding buyers. Should the Examiner contend that Wong shows this, he is requested to cite the column and lines of Wong doing so.

Secondly, all the action is handled by the trader. As pointed out in the specification at, for example, page 2, lines 21-25, there is little chance for an individual to purchase a patent from another individual. However, as pointed out at, for example, page 3, lines 10-11, the claimed invention facilitates the sale and purchase of intellectual property, and also of industrial property, both enabling buyers who otherwise might not be capable of locating

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industrial or intellectual property that is available for purchase and enabling sellers who otherwise might not be capable of locating buyers of their industrial or intellectual property..

Further, as pointed out at page 16, lines 14-17, because the trader handles the actions, the seller and the buyer are freed from troublesome procedures. Many individuals do not have the knowledge or other ability to do many of these things, such as locating industrial property or intellectual property that is available for purchase. Not only does the trader handling all the action free the seller and the buyer from the complicated procedure of doing so, but also it enables many individuals, who otherwise would not be capable of acquiring rights to intellectual property or industrial property, to do so.

In Wong's system, buyers and sellers must deal with each other. Individuals who do not know how, or who otherwise are incapable of doing so, are thus unable to acquire potentially valuable property rights. The claimed invention overcomes these problems. Additionally, buyers or sellers who do want their identity known are able to work through a third party trader, thus enhancing security and confidentiality.

35 U.S.C. relates to patents and sets forth the statutory provisions related to filing of patent applications, but does not disclose or suggest that which distinguishes the claimed invention from Wong.

In view of the foregoing, Applicant submits that claims 2 and 3, all the claims presently pending in the application, are patentably distinct over the prior art of record and are allowable, and that the application is in condition for allowance. Such action would be appreciated.

Should the Examiner find the application to be other than in condition for allowance,

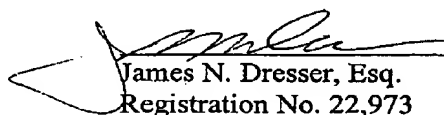
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the Examiner is requested to contact the undersigned attorney at the local telephone number listed below to discuss any other changes deemed necessary for allowance in a telephonic or personal interview.

To the extent necessary, Applicant petitions for an extension of time under 37 CFR §1.136. The Commissioner is authorized to charge any deficiency in fees, including extension of time fees, or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

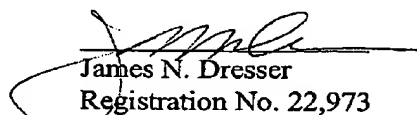
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Amendment Under 37 C.F.R. §1.116 and Submission of New Drawing Sheet Including New Figure by facsimile with the United States Patent and Trademark Office to Examiner Michael A. Cuff, Group Art Unit 3627 at fax number (703) 872-9306 this 6th day of June 2005.


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